IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

No. ———.

DIXIE ROSE NURSERY, *Petitioner,*

v.

CONWAY P. COE, Commissioner of Patents, *Respondent.*

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

JURISDICTION.

The statement of jurisdiction is set forth in the foregoing petition.

STATEMENT OF THE CASE.

The facts have been set forth in the foregoing petition.

SUMMARY OF ARGUMENT.

Point I.

The limitation contained in Section 5 of the Trade-Mark Act of 1905, prohibiting registration of *merely* descriptive or *merely* geographical marks, was solely intended to deny registration to those marks which are descriptive or geographical *as a whole.*

Point II.

Descriptiveness or geographical significance of a trade-mark may not properly be presumed or implied in the absence of strict and positive proof of such descriptiveness or geographical significance.

Point III.

The monopoly afforded by registration of a trade-mark is wholly separate and distinctly different from the monopoly afforded by a patent.

Point IV.

The history of the trade-mark practice before the Patent Office and as interpreted by this Court and other courts of the land, does not deny the right of registration to variety trade-marks for varieties of goods including varieties of plants.

Point V.

The rule in *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, and *Dupont Cellophane Co., Inc.* v. *Waxed Products Co., Inc.* (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575 does not apply to the facts and evidence in the case here before the Court.

Point VI.

Disclaimer of descriptive or geographical features of composite trade-marks is not a prerequisite to registration under the Trade Mark Act of 1905, when the trade-mark as a whole is not merely descriptive or merely geographical.

Point VII.

Adoption by a trial court of findings prepared and submitted by the winning party to the suit, as in this case, is not a sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure, in the absence of a written or oral opinion or expression of views of the court as to the sufficiency of the trial evidence to support the judgment of the court.

Point VIII.

This case is one of first impression.

ARGUMENT.

Point I.

The limitation contained in Section 5 of the Trade-Mark Act of 1905, Prohibiting Registration of MERELY Descriptive or MERELY geographical marks was solely intended to deny registration to those marks which are descriptive or geographical as a whole.

The Trade-Mark Act regulating registration of trade-marks is an outgrowth of the broader principles of law established for the purpose of preventing unfair competition in trade. The sole intent of those provisions of the Act which prohibit registration, is to avoid the likelihood of confusion in the mind of the public as to the origin or identity of the merchandise to which the trade-marks are applied.

Section 5 of the Act, which is the section we are particularly concerned with here, prohibits registration of trade-marks which are merely descriptive or merely geographical. The clause in question reads as follows:

> "*Provided,* That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act:"

It will be observed that the words of the Act explicitly designate the inhibition against those marks which consist merely in words or devices which are descriptive of the goods, or of the character or quality of such goods. The language is not so broad as to inhibit registration of a composite trade-mark which is made up of arbitrary or fanciful features, plus a descriptive or geographical feature.

Accordingly, the only proper construction of the Act requires that the registrability of a composite trade-mark must be determined in the light of the mark *as a whole,* and not from its individual elements separately.

In this respect, the case comes within the principle applied by this Court in Estate of *P. D. Beckwith* v. *Commissioner of Patents* (252 U. S. 538), where this Court, in passing on this very question, stated:

> "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."

The question of geographical significance of composite trade-marks was likewise passed upon by this Court in the case of *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.,* 240 U. S. 251, where this Court appropriately stated the applicable principle as follows:

> "We do not regard the words 'The American Girl,' adopted and employed by complainant in connection with shoes of its manufacture, as being a geographical or descriptive term. It does not signify that the shoes are manufactured in America, or intended to be sold or used in America, nor does it indicate the quality or characteristics of the shoes. Indeed, it does not in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture. We are convinced that it was subject to appropriation for that purpose. * * *
>
> The cases cited to the contrary are distinguishable. In *Delaware & H. Canal Co.* v. *Clark* (13 Wall. 311, 324, 20 L. Ed. 581, 583), the word 'Lackawanna' was rejected as a trade-mark for coal because it designated the district in which the coal was produced. * * * If the mark here in controversy were 'American Shoes,' these cases would be quite in point. * * * The phrase is quite analogous to 'American Express', held to be properly the subject of exclusive appropriation as a trade-mark for sealing wax in *Dennison Mfg. Co.* v. *Thomas Mfg. Co.,* (94 Fed. 651, 653)."

The foregoing cases have clearly established and settled the true meaning and intent of the language of the Trade Mark Act, and have served as a guide to the practice for many years. The only explanation for the grant of thousands of registrations for variety trade-marks which have been issued since the enactment of the Trade Mark Act up to the present date, and of which the many registrations of petitioner's exhibits here in evidence (Pl. Exs. 3, 4, 12, 13, 14, 15, 16, 17, 19 and 20) are illustrative, is to be found in the above interpretations of the Act by this Court.

Construing the Act in the light of the foregoing principles, it follows that petitioner's composite trade-mark is neither descriptive of the goods nor geographical within the meaning of the inhibitions of the Act.

With all deference to the Patent Office and the courts below, we submit that the language of the Act under consideration has been too broadly applied, so far as petitioner's trade-mark has been held to be descriptive of a particular variety of rose and therefore is unregistrable under the Act. Neither the words "Texas Centennial" alone, nor the mark as a whole describes a rose or any character or quality of a rose. If the mark were merely "Texas Roses", then it might properly have been held that the mark was both descriptive and geographical, but that is not the mark here in issue. On the contrary, paraphrasing the language of this Court in the Hamilton-Brown Shoe case, *supra*, petitioner's mark does not signify that the roses are grown or produced in Texas, or intended to be sold in Texas; nor in fact does the mark in its primary signification indicate roses at all.

Point II.

Descriptiveness or geographical significance of a trade-mark may not properly be presumed or implied in the absence of strict and positive proof of such descriptiveness or geographical significance.

Petitioner, essaying under Section 4915 R. S., to try in a court of equity the issue of registrability of its composite trade-mark "Texas Centennial" and design (determined adversely to it in the Patent Office proceedings), adduced abundant evidence of intention to adopt and use, and the fact of adoption and use of its mark in interstate commerce, commencing in November, 1935 (Tr. 41, 42); filing of application for registration of the mark in April, 1936, (Pl. Ex. No. 1) as applied to roses, scions and cuttings of the new variety then and since known to the trade and to the public in general by the generic or descriptive name "Red Hoover" (Tr. 41-46) (a red sport of the earlier known yellow rose variety "President Herbert Hoover"); patenting of the new variety in January, 1936 (Tr. 45); extensive advertising of the rose under the trade-mark "Texas Centennial" in association with the generic name "Red Hoover" (Pl. Exs. 5, 6 & 7, 33); and the understanding by and meaning to the trade and to the public that the mark was truly significant of origin in petitioner, and was employed in precisely the same manner as variety trade-marks have been universally used upon many different varieties of goods in other fields of commerce (Tr. 42, 43 and 54-83 inc.).

This was all in accordance with the course of equity and the usual and correct practice in a suit under Section 4915 R. S., which applies to trade-mark cases as well as to patent cases (U. S. ex rel, the *Baldwin Company* v. *Robertson*, 265 U. S. 168, 179; *Hygienic Products Co.* v. *Coe*, 85 F. (2d) 264, 265.

Respondent, however, adduced no countervailing evidence whatever.

Petitioner's evidence having abundantly proved that the trade-mark denotes origin of the goods in petitioner, as

was originally intended, was so understood by the trade and by the public, and is not descriptive of the goods, this put respondent to its proofs to the contrary. Respondent's failure to adduce any countervailing evidence, left the Courts below, we submit, nothing to do but enter judgment for petitioner.

In spite of the only evidence in this case establishing the truly arbitrary and non-descriptive character of petitioner's mark here in issue, the District Court below rendered judgment in favor of respondent. The District Court wrote no opinion, but found as matter of fact that the trial evidence established that "Texas Centennial" is the variety name of the rose covered by Plant Patent No. 162, and produced and sold by petitioner and by others under license from petitioner, and that this name has not been applied to any other rose or plant. These findings appear at page 7 of the transcript of the record. The District Court then came to the conclusions that the words "Texas Centennial", being a variety name, are descriptive of roses to which these words are applied, and, therefore, cannot be registered under the Trade Mark Act of 1905. These conclusions are found at page 8 of the transcript of the record.

The Court of Appeals, on appeal to that Court, affirmed the judgment of the District Court dismissing the complaint (see order of dismissal, Tr. 107), said affirmance being based upon a wholly new theory that if a name originally arbitrary and not descriptive, is applied for a considerable period to a new invention and to nothing else, the name would come to identify or describe the thing as the word "cellophane" has come to describe a thing. In this connection, the Court of Appeals gave no guide for the meaning of the expression "considerable period", and in referring to the "cellophane" illustration it has misapplied a doctrine, there involving a period extending beyond the life of a patent, to the facts of the present case where the application for registration was applied for in the Patent Office less than five months after adoption and use of the mark upon the goods.

Thus, the descriptive significance ascribed by the Court of Appeals below to petitioner's trade-mark is a presumption not supported or justified by the evidence in the case. The presumption is, accordingly, at variance with the principle of law long established in trade-mark practice and approved by this Court, as found in the case of *President Suspender Co.* v. *Macwilliam* (C. C. A. 2), 238 Fed. 159, cert. den. 343 U. S. 636. In that case the Court said:

> "The fact that the name 'President' has come to indicate the invention and constitutes its generic description is one of fact, to be proved by evidence. There is no evidence in this record that the word 'President' has ever come to indicate to the public the generic description of the suspender of the patent. The only evidence in the case indicates that it is a mark of origin, indicating the plaintiff, its business, and its goods. There is no presumption of law, without proof of the fact as above indicated, that a name used on a patented article passes to the public on expiration of the patent."

The foregoing applies precisely in the same manner to the unrebutted evidence offered by petitioner in the trial court below.

To the same effect is *Scandinavia Belting Co.* v. *Asbestos and Rubber Works of America* (C. C. A. 2), 257 Fed. 937, cert. den. 250 U. S. 644.

Were the principle of the President Suspender case, *supra*, applied to this case by the court below, the only proper conclusion which could have been reached by the court would have been that petitioner's trade-mark is registrable under the Act.

Point III.

The monopoly afforded by registration of a trade-mark is wholly separate and distinctly different from the monopoly afforded by a patent.

The conclusion of the Court of Appeals below to the effect that to allow registration of petitioner's trade-mark would give to petitioner an unfair advantage despite the fact that only petitioner and its licensees produce the particular variety of rose to which the trade-mark is applied, and that it would tend to prolong petitioner's monopoly beyond the life of its patent by making it difficult for a newcomer to break into the field, is completely at variance with a former decision of that Court in the case of *In Re Pitney-Bowes Postage Meter Co.*, 6 F. (2d) 717. In that case, the Court appropriately recognized that the monopoly afforded by the registration of a trade-mark is wholly separate and distinctly different from the monopoly afforded by a patent. This principle has been repeatedly announced by various Circuit Courts of Appeals which have held that a subsequently granted patent on the article cannot affect the established trade-mark, as exemplified by the following cases, namely:

Sawyer v. *Kellogg* (C. C. D. N. J.), 7 Fed. 720;
Batcheller v. *Thompson* (C. C. A. 2), 93 Fed. 660.

In fact, the monopoly afforded by a statutory registration under the Act of 1905, is not a monopoly at all on either the goods or the words themselves. That is to say, registration of a trade-mark does not create any *new right* which is greater than the right of freedom from unfair competition afforded by the common law, but on the contrary, registration goes to the codification of the administrative procedure of registration, and the remedies for infringement to give greater effect to the protection against unfair competition. As this Court well knows, most of the articles of commerce today are patented, and to prohibit registration, during the life of the patents, of those trade-marks used on

patented articles or patented plants, as in the case here, would constitute judicial legislation because such prohibition is not found in the Trade-Mark Act itself, and would bar registration of the majority of trade-marks. This is clearly contrary to the intent and express terms of the Act.

This principle was apparently recognized in the instant case by the Assistant Commissioner of Patents who overruled the rejection of petitioner's application for registration by the Examiner of Trade Marks, so far as based on the ground that petitioner's mark was the name of a patented article. Therefore this question was not made an issue in the proceedings under 4915 R. S., as the pleadings show, in spite of which, the judgment below appears to have been based primarily on the very existence of a patent on the goods, and to that extent, petitioner has been penalized for having obtained a patent after applying for registration of its trade-mark, notwithstanding the common practice of the Patent Office to register trade-marks for patented products.

Having in view that the evidence here shows that petitioner's patent on the goods has not expired, and was in fact granted after filing of application for registration of the trade-mark, there is no proper basis for the conclusion of the Court of Appeals below that the grant of registration of the mark in issue would extend petitioner's monopoly beyond the life of its patent.

Point IV.

The history of the trade-mark practice before the Patent Office and as interpreted by this Court and other courts of the land, does not deny the right of registration to variety trade-marks for varieties of goods including varieties of plants.

The numerous registrations (such as "Ivory", "P and G", "Swan" etc., for different varieties of soaps; "Post Toasties", "Krumbles", "Pep" etc., for different varieties of cereals; "Lucky Strike", "Herbert Tareyton". "Ches-

terfield" etc., for different varieties of cigarettes; "Blackjon," "Seeando," "Richared" etc., for different varieties of apples; "Texas Centennial" for a variety of wine, etc.) granted over a period of many years since the passage of the Trade Mark Act of 1905, as evidenced by those hundred or so registrations selected at random and offered in evidence by petitioner, show quite clearly the manner in which the Act has been consistently interpreted by the Patent Office and as fully justifying the registration of petitioner's mark.

As recently as January 6, 1943, since this case was decided by the Court of Appeals below, in Ex parte W. F. Hebard & Co., 56 U. S. P. Q. 114, the Assistant Commissioner of Patents Van Arsdale said:

> "To my mind, it is immaterial to the right of registration that the name 'shop mule' may not have been descriptive of an industrial tractor at the time applicant first adopted the mark for such machines. *It is the date of filing for registration that controls.*" (Italics ours)

Accordingly, even now the Patent Office is not giving effect to the theory of the decision below, any more than did the Patent Office apply its own customary rule of the Hebard case, *supra*, to the instant case, having in mind that petitioner filed application for registration within five months after adoption and use of its mark, and before the patent on the goods was obtained. If the date of filing controls, there obviously was no lapse of a considerable period of time comparable to the theory in the Singer and Cellophane cases, *supra*, where the time factor involved at least the full life of the expired patent (17 years).

Again, within three days after the decision below, the same Assistant Commissioner of Patents in Ex parte Eastman Kodak Co., 55 U. S. P. Q. 361, speaking with reference to the trade-mark "D-11" as applied to only one specific type of photographic developer upon which the mark "D-11" was used by the Eastman Kodak Company, held as follows:

"It seems to me the present mark is of the same class as the mark 'La Favorita' in Menendez v. Holt, 128 U. S. 514, 1889 C. D. 344, 46 O. G. 971. In that case it appears the marking of the goods included both the mark 'La Favorita' and the name of the distributor of the goods. The goods were a particular flour and the mark had been used to distinguish that particular flour selected and prepared by the distributor. The mark did not, in itself, indicate quality, being merely a fancy name, but the court found the mark evidenced that the distributor's skill, knowledge and judgment had been exercised in the selection of the flour. The court held that under such circumstances the mark 'deserves protection rather than that it should be debarred therefrom, on the ground, as argued, of being indicative of quality only.'

Applicant's mark does not appear to denote or to be intended to denote type or quality only but is also intended to and does denote the origin of the goods. In my opinion the mark gives amply sufficient indication of the origin of the goods to which the mark is applied to warrant allowance of the application and the passing of the mark to publication, *notwithstanding the fact that the labels show the mark applied to only one specific type of developer.* Menendez v. Holt, supra, Richard Hellman, Inc. v. Oakford & Fahnestock, 19 C. C. P. A. 816, 54 F. 2d 423, 1932 C. D. 160 (12 U. S. P. Q. 31).

In addition I may say that in my opinion if the mark 'D-11' were displayed on packages of photographic developers compounded and sold by others than applicant purchasers would be likely to be misled and deceived into believing that those developers were made by the Eastman Kodak Company. It seems that confusion as to source of origin of developers would be more likely to result from refusal to allow registration than from allowing registration, and it is an object of the Trade Mark Act to avoid such confusion. *Attention has been called to the fact that applicant has applied for trade mark registration of six other notations for developers compounded in accordance with other formulas, but this seems to be immaterial since it is conceded that the mark of the instant application serves as a grade mark; but as stated, I consider the mark also*

is sufficiently indicative of the source of origin of the goods to which the mark is applied to entitle it to registration. Also the examiner appears to concede that the mark indicates that the particular type of developer to which the mark is applied is made by applicant. The fundamental question is not whether or not the mark as used by applicant serves to indicate grade or quality but rather whether it is or is not so used that purchasers and the public will recognize the mark as indicating the source or origin of the goods. *I see no conflict between the authorities on this point.*" (Emphasis ours)

Still later, on January 21, 1943, the same Assistant Commissioner held the mark "5897", *as used upon a particular strain of seed corn,* to be a registrable mark under the Act of 1905, on the authority of *Menendez* v. *Holt* hereinbefore referred to (see *Ex parte Pfister Hybrid Corn Co.*, 56 U. S. P. Q. 275). The Assistant Commissioner said:

"Notwithstanding the fact that the mark may indicate one particular strain of applicant's seed corn nevertheless in my opinion the mark as it is applied to applicant's goods is sufficiently indicative of the true source of origin of the goods to which the mark is applied to entitle the mark to registration under Act of February 20, 1905."

A *strain* of seed corn is simply another term for *variety* as this latter term is referred to herein in connection with the variety trade-mark in issue for roses, and the hundred or so variety trade-mark registrations offered in evidence by petitioner.

Thus, the very history of the practice before the Patent Office is a far safer and more accurate guide to the intent and meaning of the Trade Mark Act of 1905 than the theoretical reasoning in the decision below. In other words, the Court of Appeals below has announced a wholly new theory or interpretation of the Trade Mark Act, which, if followed, would radically change the prevailing practice. In spite of this new theory or interpretation of the Act, the foregoing recent decisions of the Patent Office, coming after the decision below, show that the Patent Office even now is not following the court's theory, and unless this Court

grants the writ of certiorari, the decision below will stand as an unreasonable and unfair discrimination against petitioner, and in effect, against the entire plant industry.

Referring to the case of *Menendez* v. *Holt*, 128 U. S. 514, cited in the foregoing decisions of the Patent Office, this Court has there clearly established the principle that where the intention is to acquire a trade-mark, the mere fact that the name may also serve to designate a particular kind, grade, or quality of the article manufactured does not prevent the creation of a trade-mark right in it and does not prohibit registration of the mark under the Act of 1905.

Both the "La Favorita" trade-mark involved in the *Menendez* v. *Holt* case and the "Texas Centennial" mark in issue here, are variety trade-marks used on particular vendable commodities, and petitioner's composite trade-mark accomplishes a purpose precisely like that of the "La Favorita" trade-mark in the *Menendez* v. *Holt* case.

The same doctrine was reiterated by this Court in *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U. S. 537, where it was further observed by this Court that the primary object of the adoption by the trade-mark proprietor of the trade-mark in question was to symbolize the exercise of the judgment, skill and particular knowledge of the proprietor who adopted and used it.

This doctrine was not changed by *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, which does not involve the question presented here, but rather which concerns the loss of trade-mark significance *after* expiration of the patent.

Point V.

The rule in Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 186, and Dupont Cellophane Co., Inc. v. Waxed Products Co., Inc. (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575, does not apply to the facts and evidence in the case here before the Court.

As indicated above, the rule announced by this Court in the Singer case does not apply to the facts and evidence in the case here before the Court, and, therefore, the conclu-

sion of the Court of Appeals below to the effect that "It is conceived to be unfair to require buyers who are indifferent to source, and want merely goods of certain characteristics, to name a particular source in order to name the desired characteristics" is based upon a supposed constraint of a decision of this Court.

Nothing in the rule of the Singer case, properly understood and properly applied, compelled any result below other than the entry of judgment for petitioner, or justified the extension of the rule beyond the kind of suit (to wit, infringement of a *registered* trade-mark *after* expiration of the patent on the goods) and the situation of proofs (to wit, proofs definitely showing without necessity of presumption that the marks never had been used in other than a descriptive sense) there before the Court, for the reasons fully set out in the petition which need not be repeated.

Likewise, the Cellophane case relied upon by the Court of Appeals below is inapplicable to the case here before the Court for the same reasons mentioned above in connection with the Singer case.

The present case is definitely distinguished from both of the above cases by reason of the fact that petitioner's trade-mark was adopted and used before the grant of its patent, and the patent is even now not yet expired. Moreover, petitioner has applied its trade-mark to goods having a separate and distinct generic name "Red Hoover" well known to the public and to the trade in general, as distinguished from the use of trade-marks in no other but a descriptive sense in the Singer and Cellophane cases, and the absence of any other name by which the goods in those cases could be identified.

Point VI.

Disclaimer of descriptive or geographical features of composite trade-marks is not a prerequisite to registration under the Trade-Mark Act of 1905, when the trade-mark as a whole is not merely descriptive or merely geographical.

In the proceedings before the Patent Office, the Assistant Commissioner of Patents, after the close of the prosecution of petitioner's application for registration, held that the word "Texas" and the shape outline of the State of Texas are geographical "and their disclaimer on that ground would be required even were the mark otherwise unobjectionable." This ruling was not strictly a requirement of disclaimer, but even if it were intended to be such a requirement, it came too late since the prosecution of the application was closed. However, if this Court should interpret its former decision in Estate of *P. D. Beckwith* v. *Commissioner of Patents* (252 U. S. 538), as intending to require disclaimer as prerequisite to registration, then such disclaimer can be entered in the case when it is remanded to the Patent Office, should the mark be otherwise adjudged registrable.

In spite of the absence of any definite requirement of disclaimer in the proceedings before the Patent Office, the District Court below found as a conclusion of law that the word "Texas" and map outline of the State of Texas are merely geographical and in view of petitioner's failure to disclaim them, the petitioner is not entitled to registration under the Act. (Tr. 8)

The Court of Appeals in passing on the question of geographical character of the mark, merely held that the addition of the geographical name "Texas" and map does not entitle the mark to registration, and to this extent, the finding by the District Court to the effect that a disclaimer is prerequisite to registration of the composite mark as a whole, is not definitely affirmed and leaves this particular issue unsettled.

The Beckwith case above referred to, as petitioner understands the purport of the decision of this Court there, was not intended to write into the Trade Mark Act a new requirement which is not referred to in the Act itself, having regard for the fact that the Act makes no provision whatever for disclaimers, and certainly does not require disclaimers of descriptive or geographical features of a composite mark. The particular situation before the Court in that case was whether voluntarily disclaimed subject matter had to be obliterated or erased from the drawing of the application for registration. The Court held that such obliteration or erasure was not necessary and went no farther than to express approval of the practice of permitting disclaimers in lieu thereof. Accordingly, this is a situation which should be elucidated by this Court in the application of the principle of the Beckwith case to suits based on the pleadings and proofs like the instant case, to the end that the rights and duties, and the proper practice and procedure of applicants for registration under the Trade Mark Act, may be clarified.

Point VII.

Adoption by the trial court of findings prepared and submitted by the winning party to the suit, as in this case, was not a sufficient compliance with rule 52(a) of the Federal Rules of Civil Procedure, in the absence of a written or oral opinion or expression of views of the court as to the sufficiency of the trial evidence to support the judgment of the court.

One of the issues raised by this Petitioner in the Court of Appeals below, but which was not passed upon by that Court, involves the question of whether there was a sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure, in the adoption by the District Court of findings prepared and submitted by counsel for respondent, without benefit of any expression of views of the Court whatever (either by opinion or otherwise) as to the trial

evidence. This practice has been condemned by at least one Circuit Court of Appeals as in the case of *United States* v. *Forness*, (C. C. A. 2), 125 F. (2d) 928, where the Court said:

> "We have recently asked for 'brief and pertinent findings of contested matters * * * rather than the delayed, argumentative, over-detailed documents prepared by winning counsel.' *Matton Oil Transfer Corp.* v. *Tug "Dynamic,"* 123 F. (2d) 999 (5 Fed. Rules Serv. 25a.11, Case 2) (Dec. 1, 1941). Otherwise, we lose the benefit of the judge's own consideration. In the instant case, a comparison of the findings with the opinion seems to show that the findings proposed by the defendants were mechanically adopted, with the consequence that some of the findings made by the district court are not supported by the evidence and not substantially in accord with the opinion."

The object of the rule in question is aptly stated in the discussion of the Federal Rules of Civil Procedure at page 27 of 1 F. R. D. by Judge Gunnar H. Nordbye of the U. S. District Court at Kansas City, who said as follows:

> "I like the clear and succinct statement of our text writer in Minnesota, Mark B. Dunnell, who states, in referring to the Minnesota statute:
> 'The objects of the statute to require the court to give its decision in writing and to state the facts found and conclusions of law separately, are to abolish the doctrine of "implied findings"; to make definite and certain just what is decided, not only for the purpose of the particular action, but also for the purpose of applying the doctrine of estoppel to future cases; and finally to separate questions of law and fact so that they may be more conveniently, intelligently and fairly considered and reviewed on a motion for a new trial or on an appeal.' "

Also, the following from page 29 of the same discussion:

> "I feel that counsel have a right to the judge's views and the reasons which prompted him to the decision which was reached. It tends to inform counsel that

some consideration at least has been given to the conflicting contentions that have been advanced, and that the views of losing counsel have not been simply brushed aside."

Accordingly, the issue raised in the present case calls for an interpretation by this Court of the meaning and intent of said Rule 52(a), in the exercise of this Court's power of supervision, in the determination of the question of whether the proceedings below so far departed from the accepted and usual course of judicial proceedings as to countenance the entry of a judgment below which is without evidence to support it and which is contrary to the only evidence adduced.

Point VIII.

This case is one of first impression.

The present case is the first case, as far as petitioner is aware, in which a court has held before expiration of the patent, that a trade-mark applied to a patented product, loses its trade-mark significance by exclusive use on such product alone, and upon nothing else.

This question has remained unadjudicated in any proceeding arising out of the proceedings in the Patent Office on an application for registration. For the reasons hereinbefore given, the rule of the Singer and Cellophane cases is not applicable, because these cases were dealing with a totally different question, namely, the loss of trade-mark significance of a *registered* trade-mark *after* expiration of the patent.

This case is also the first case, as far as petitioner is aware, in which the right of registration of a variety name trade-mark, as such, has been directly raised under the Trade-Mark Act of 1905.

Accordingly, if the judgment below is permitted to stand, petitioner will be denied its right to registration of its trade-mark under the Trade Mark Act upon a misinterpretation and misapplication of the rule in the Singer and Cellophane

cases, and the practice in the lower courts will be revolutionized without sanction of this Court and in direct opposition to former decisions of this and other Courts, as previously shown herein. Moreover, the decision of the Court of Appeals below casts a cloud upon thousands of registrations for variety trade-marks for different varieties of goods, which have already been registered by the Patent Office, as evidenced by the illustrative examples adduced in evidence by petitioner in this case. The issue here, therefore, is not only of interest to the particular litigants, but is also a matter of interest to the public in general, and to an entire industry (the plant industry).

CONCLUSION.

It is respectfully prayed that the petition for certiorari be granted.

Respectfully submitted,

HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.,
Attorneys for Petitioner.